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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,159

02/13/2006

Giuseppe Caputo

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5913

26868 7590 11/10/2008

HASSE & NESBITT LLC  
8837 CHAPEL SQUARE DRIVE  
SUITE C  
CINCINNATI, OH 45249

EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

11/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,159	<b>Applicant(s)</b> CAPUTO, GIUSEPPE	
	<b>Examiner</b> YONG CHU	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,8,9 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) 6,8,9 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2, and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 5, 7, 10 and 13 are cancelled. New claims 14-16 are added. Therefore, claims 1, 2, 4, 6, 8-9 and 14-16 are currently pending in the instant application.

### ***Response to Amendment***

The amendment by Applicants' representative Mr. Daniel F. Nesbitt dated on 07/16/2008 has been entered.

### ***Response to Arguments***

#### **Restriction and Election**

Applicant's argument regarding restriction requirement has been fully considered, but not persuasive. The amended claims 6, and 8-9 depend on new claims 14-16, which further comprises a bimolecular conjugated through the linker arm  $-R_1-C\equiv CH$ . The new claims 6, 8-9 and 14-16 patentably distinct from claims 1, 2, and 4, and the references render claims 1, 2, and 4 unpatentable may not render claims 6, 8,9, and 14-16 unpatentable. Therefore, claims 6, 8, 9, and 14-16 require further search and examination. Accordingly, claims 6, 8, 9, and 14-16 are withdrawn from further consideration as non-elected subject matter. Claims 6, 8, 9, and 14-16 may be subject to rejoinder for further examination if claims 1, 2, and 4 are found allowable.

#### **Claim priority or incorporation of foreign priority claim**

Applicants are not aware of any requirement of identifying foreign priority application within the specification. The Examiner would like to draw applicants' attention to MPEP201.11 for the reason, see the attached document. Since Applicants

does not disclose such information in either the first sentence of the specification nor in ADS, **the claimed foreign priority to PZ2003000002 is not recognized.**

**Claim rejection under 35 U.S.C. § 101**

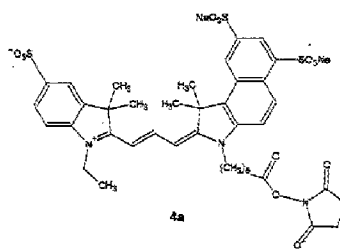
The rejection of claim 13 is moot, because the claim has been cancelled.

**Claim rejection under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, enablement**

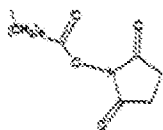
The rejection of claim 13 is moot, because the claim has been cancelled.

**Claim rejection under 35 U.S.C. § 103(a)**

Applicant's argument over the 103a rejection is on the ground that Claim 1 requires that "one of R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub> and R<sub>6</sub> is -R<sub>8</sub>-Y", and that a substituent group "-R<sub>8</sub>-Y" could not be identified at any position on the rings of the "indocyanine 4a" of the '421 application. See page 13 of the response on 07/16/2008. Applicants' argument has been fully considered, but not persuasive. The proviso in claim 1 of the instant application states "provided that one of R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub> and R<sub>6</sub> is -R<sub>8</sub>-Y;" see page 2 of the claim 1. The substituent R<sub>2</sub> directly attaches to the nitrogen atom of the indole ring.



For the cited '421 compound 4a, the "corresponding R<sub>2</sub> to the



instant application" is " ", which reads on the instant definition of "-R<sub>8</sub>-Y", wherein R<sub>8</sub> is a linear alkyl chain, and Y is a carboxyl. Therefore, the proviso does not exclude the cited '421 compound 4a. Furthermore, R<sub>2</sub> is used as a linker to attach to

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the other biological macromolecules was taught in the cited `247 application as a reacting group capable of forming a linkage with a biological target function as a bio-probe. See page 8 of the previous Office action. In terms of the argument by Applicants that the `421 application teaches away from the feature that the compounds with "carboxylalkyl or sulfonatoalkyl chains or electron withdrawing groups in the benzene ring" would decrease the reactivity of the indolenines and defeat the purpose of the "general strategy synthesis" taught in the `421 application's paragraph [0014], the Examiner does not agree. First, if a compound with "carboxylalkyl or sulfonatoalkyl chains or electron withdrawing groups in the benzene ring" would decrease the reactivity of the indolenines, why the instant application claims the such less active compound as the Formula (Ic) in claim 4 for the same application? Second, the instantly rejected compound has a carboxylalkyl chains or linker to the nitrogen of the heterocyclic indole ring, not a benzene ring as being argued by Applicants; Last, a carboxylalkyl linker is a very common linker as part of carboxylalkyl succimide ester for conjugating a dye to a biological molecule. Therefore, the previously cited references render the instant claims obvious, and the rejection is maintained.

**Double patenting rejection**

The double patenting rejection is maintained. Please refer the analysis provided above.

**Claim Objection**

The claim objection is provisionally maintained, because the claims are not allowable.

### ***Conclusions***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong Chu/  
Patent Examiner  
Art Unit 1626

/Kamal Saeed/  
Primary Patent Examiner  
Art Unit 1626